REMARKS

The Amendments

Claim 5 (in the elected invention) is amended to re-write it in independent form.

The amendment does not narrow the scope of the claims and/or were not made for reasons related to patentability. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction Requirement

In response to the restriction requirement set forth in the Office Action mailed July 25, 2003, Applicants hereby elect Group II, claims 5-7, 14 and 15, drawn to a method of preparing a bis(perfluoro-n-alkanesulfonate) compound. The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one of more divisional applications directed to the non-elected subject matter.

Initially, the restriction requirement is traversed on the grounds that it is inconsistent with the prosecution conducted in the parent application, now issued as Patent No. 6,353,125. The parent application contained claims which were related in the same manner as the instant claims, i.e., product, process of preparation thereof and process of using the product to

prepare another compound. Although an Election of Species was made in the parent application, no restriction requirement was made. The claims to each of the product, process of preparation thereof and process of using the product to prepare another compound were all issued in the '125 patent. The instant claims are directly analogous to those of the parent patent as to the nature of the invention and relation of the claims, differing only in the species. The instant claims relate to compounds having at least one heteroatom replacement. No reason is given as to why the instant claims should be treated differently than in the parent application. The inconsistency in such treatment is unwarranted and harmful to applicants. The restriction should, therefore, be withdrawn at least for this reason.

Additionally, the basis given in the Office Action to support the restriction is incorrect. The Office Action states that the process as claimed – presumably the process of Group II – "can be used to make a materially different product such as preparation of a diphosphine of formula III as demonstrated in group III." But this is clearly not accurate since the process of group II cannot be used to make the diphosphine which is shown to be made by the process of group III. The process of group II is for making the compound of formula I and the process of group III is for using the compound of formula I to make a different compound of formula III. The process of group II cannot be used to make the diphosphine; it only makes the starting material used to make the diphosphine. Because the alleged basis for the restriction is clearly incorrect, it is even more evident that the restriction should be withdrawn.

As to the restriction between Groups II and III, while it is true that they relate to different processes for preparing different compounds, they are clearly closely related since the process of Group II prepares the starting material used in the process of Group III. The PTO practice clearly allows for a single patent reciting a product, a process for making it and

a process for using it where the processes relate to making and use of the same scope as the product; see, e.g., M.P.E.P. § 806.05(h). In fact, this is exactly what was done in the parent application and the practice should be consistently followed here. Thus, the restriction should be withdrawn.

As to the restriction between Groups I and III, the Office Action erroneously states that these groups are related to a set of structurally diverse and dissimilar compounds. This is clearly wrong since Group III is not directed to compounds but to a process of using compounds to make other compounds. As discussed above, Group III relates to a process of using the compounds of Group I. They are clearly and closely related and should be examined together.

For all of the above reasons, the restriction should be withdrawn as a whole.

The Election of Species Requirement

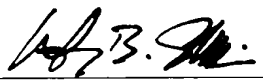
Pursuant to the Election of Species requirement made in the Office Action, applicants elect the species of the method of preparing an optical enantiomer of binaphtholdinonaflate, as described in Examples 1 and 2, page 24-25, of the instant specification. It is believed that claims 5-7, 14 and 15 all encompass the elected species.

The examiner is encouraged to examine the broadest possible scope of invention indicated by the elected species. In accordance with M.P.E.P. § 803.02, the examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. It is improper for the PTO to refuse to examine in one application the entire scope of the claims therein unless they lack unity of invention. The generic claims herein have not been alleged to lack unity of invention.

Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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